

REMARKS

In regard to the Examiner's Office Action of May 5, 2005, Applicants would herein provide the following considerations and responses.

In regard to Examiner's rejection under 35 USC 102(e), as anticipated by the two patents to Smorodinsky (Smorodinsky-1 and Smorodinsky-2) and to the Mackey patents (Mackey-1 and Mackey-2), Applicants would acknowledge that the inventors of these applications are not the same as the inventors of the instant application, USSN 09/813,668. However, Applicants will later argue that it is improper for the Examiner to select bits and pieces from various separate references in order to integrate them and reconstitute these bits and pieces in order to reinvent Applicants' invention.

On page 3 of Examiner's Office Action, Examiner disagreed with regard to the co-pending applications of USSN 09/813,667 and 09/813,671, as disclosing certain limitations. Further, Examiner has indicated he could not find support for certain limitations (application that processes 16-bit or MS-DOS programs accumulating the number of User-type Users) in Applicants' co-pending USSN's 09/813,668, 09/813,667 and 09/813,671.

Applicants would traverse this consideration and indicate that this information will be found in USSN 09/813,668 in Fig. 2A, for example, in steps E10, E4, and other steps of USSN 09/813,668.

In regard to the Examiner's citation of four prior Unisys patents, the Examiner has indicated under 35 USC Article 102(e), that in such a situation there is no basis for arguing that commonly-owned prior patents are inapplicable. In this case, Examiner says they are applicable according to the Examiner, especially so, since two of the references to Smorodinsky are not the same inventors as in this application USSN 09/813,668 (Docket 041-513-L). Likewise, two other references to Mackey are also different inventors from that of the inventors of USSN 09/813,668 (Docket 041-513-L).

The Examiner has stated that co-pending applications USSN 09/813,667 (Docket 041-509-L), USSN 09/817,671 (Docket 041-510-L), and USSN 09/817,668 (Docket 041-513-L), do not provide support (according to the Examiner's review) for certain steps of the claims.

Here, we will have to indicate to the Examiner and indicate that USSN 09/817,668 (Docket 041-513-L), as seen in Figs. 1A, 1B, 1C, 1D and Fig. 2, actually do show and illustrate the various steps required to effectuate the applications involved.

Further, in USSN 09/817,668 (Docket 041-513-L), the Description starting at page 22 of the Specification goes into great detail and gives specific examples of the usage of the programs and algorithms shown in Figs. 1A, 1B, 1C and Fig. 2.

Examiner contends that claims 2-11 are rejected for indefiniteness under 35 USC 112, 1st paragraph, for failing to comply with the written description requirement. The Examiner says the subject matter is not described in the specification as

to reasonably convey to one skilled in the art how to make and use the invention.

Applicants' would traverse this argument, for example, pages 22-27 of the Specification on USSN 09/813,668 (Docket 041-513-L) actually shows in great detail the explanation of Figs. 1A, 1B, 1C, and Fig. 2, which provide specific illustrations of how these algorithms are applied so that anyone practiced in this art could surely understand how the invention is implemented.

Further, as was cited in the Cross-References, showing the Smorodinsky patents, and the Mackey patents (which Examiner contends are anticipatory of this application, (Docket 041-513-L) --- this further indicates how those skilled in the art could understand and apply the factors presented in Applicants' present invention, USSN 09/813,668 (Docket 041-513-L), since the Smorodinsky and Mackey patents are incorporated by reference in the present application.

Examiner says -- the Specification does not contain subject matter containing any software or hardware to implement certain additional limitations-----. Here, Applicants would indicate Fig. 3 of the instant application, USSN 09/813,668 (Docket 041-513-L), which certainly indicates not only hardware limitations, but also software limitations which were described in the companion cases also incorporated by reference which include USSN 09/813,667 (Docket 041-509-L), 09/813,671 (Docket 041-510-L), 09/813,672 (Docket 041-511-L), 09/813,670 (Docket 041-512-L) and 09/813,669 (Docket 041-514-L).

There are hardware drawings in several of the co-pending related applications which give very detailed outlines of Server Farms and groups of Server Farms which form a Metafarm, which certainly would indicate to those skilled in the art how the overall network can operate, and the Examiner should note that the technology of Smorodinsky-1 and Smorodinsky-2, plus Mackey-1 and Mackey-2 had been incorporated by reference into the instant application. This certainly would indicate that those skilled in the art could make and use the present invention!

The subject of "profile information" is intensely developed in USSN 09/813,667 (Docket 041-509-L) and in several of the other co-pending applications.

As to Examiner's contention that there is not sufficient subject matter to implement the limitations of applying different weight factors, such as 100%, 67%, etc. --- one should note that these are very definitely delineated in the examples given in Applicants' Specification, pages 22-27, plus Figs. 1A, 1B, 1C and Fig. 2 (Docket 041-513-L) of this application.

Likewise, the subject of deriving a proposed base solution of servers and Server Farms has been very definitely described in the co-pending related application USSN 09/813,670 (Docket 041-512-L). Note that the output of step E16 of Fig. 1 of the present application gets fed into step D13 of Fig. 1B of the companion case, USSN 09/813,670 (Docket 041-512-L).

Similarly, requirements of a specific customer and customer profile data have been described in the co-pending applications USSN 09/813,671 (Docket 041-510-L), and USSN 09/813,670 (Docket 041-512-L) which involve the Configuration Database template.

Each of these factors that the Examiner feels is insufficiently described or missing is supported in one or another of the co-pending related applications.

It will be noted that Applicants have cancelled claims 2-4, and Applicants have now combined the former claims 5, 6, 7, 8 and 9.

Additionally, other changes have been made in order to take care of certain items which were designated as lacking antecedents.

In regard to Examiner's statement that the specification does not provide implementation for various "weight factors", such as 100%, 67%, 50%, etc., Applicants would refer Examiner to the examples given in the instant specification USSN 09/813,668 (Docket 041-513-L) at pages 21-26 and Figs. 1, 2A, 2B.

Regarding Examiner's other considerations involving there being lack of subject matter for a base solution of Server Farms, etc., Applicants would herein refer the Examiner to the co-pending USSN 09/813,672 (Docket 041-511-L) on "MetaFarm Sizer Configuration Optimization", and USSN 09/813,670 (Docket 041-512-L) on "Solution Generation Method".

Regarding Examiner's objection to lack of subject matter for "Applications that process 16-bit or MS-DOS programs . . . Applicants would refer Examiner to the specification in the instant application, and step E3 of Fig. 2A, together with the specific examples given.

The Examiner has cited 35 USC 112 in certain claims for lack of antecedent basis. These particular citations regarding lack of antecedents have now been attended to and will be seen in the amended claims herein.

The Examiner has rejected the claims under 35 USC 102(e) as anticipated by Smorodinsky-1 and Smorodinsky-2. Additionally, the Examiner has cited Mackey-1 and Mackey-2.

Here, Applicants would cite a legal precedent related to the subject of anticipation ----- in regard to picking and choosing selected items, and then combining them to use hindsight to reject Applicants' claims. For example, in the case of Ex parte Beuther, decided by the U.S. Patent & Trademark Office, Board of Patent Appeals and Interferences, No. 2003-1818, decided 12/19/03 and indicated at 71 USPQ2d, p.1313, where the Board stated as follows:

Patent Examiner's rejection of claims for creped tissue sheet as anticipated by prior art patent disclosing tissue with soft and smooth surface will not be sustained, since Examiner relied on specific example of two-layer tissues in prior patent that did not meet basis weight limitation in application claims, combined with general basis weight ranges for two-layer tissues and broadly-described three-layer design, and since anticipation is not established when it is necessary to pick, choose and combine various portions of disclosure, not directly related to each other by teachings of reference, in order to find that application claim reads on that reference; Examiner's rejection of claims as unpatentable over same reference is also reversed since rejection is based on "eclectic" combination of portions of reference, suggested by hindsight

knowledge impermissibly derived from Applicants' disclosure. (underlines added).

Thus, Examiner's picking and choosing various aspects of the Smorodinsky-1 and Smorodinsky-2 references, and various aspects of the Mackey-1 and Mackey-2 references, in order to pick and choose various aspects in light of the hindsight of Applicants' present disclosure --- this is to be considered an impermissible type of rejection on the part of the Examiner.

Here, it should be noted that the Smorodinsky-1 patent, U.S. Patent 6,496,948, is involved in "Method For Estimating The Availability Of An Operating Server Farm" which involves a program for estimating the Server Farm size and the availability of the Server Farm for a given redundancy factor and a given particular number of clients.

Now, likewise, the reference to Smorodinsky-2, U.S. Patent 6,571,283, involves a method for Server Farm configuration optimization. This involves an estimator program for estimating the optimum Server Farm size and the availability of the Server Farm for a given redundancy factor and a given particular number of clients.

Then, we come to the cited reference to Mackey-1, U.S. Patent 6,567,767. This involves a "Terminal Server Simulated Client Performance Measurement Tool", which involves a performance measurement tool to measure performance of a terminal server servicing multiple clients who operate on remote systems in a Farm of multiple personal computers. A record is kept of designated simulated-user initiated actions, such as log-on times, time to open application programs, etc., to determine acceptable operating configurations.

Then, when there is Examiner's cited reference of the Mackey-2 patent, U.S. Patent 6,691,259, which involves a "Terminal Server Data File Extraction And Analysis Application". Here, parameters are evaluated over a sequence of different operating conditions during periods where the parametric evaluations occur when there is a small number of users, and then over a sequence of expanded operations until there is a large number of concurrent active client users. Here, a database is created and used to create a graphical chart of performance and specific lists of performance for each client-user correlated to each available application program.

Now, keeping in mind the above-stated Smorodinsky-1 and Smorodinsky-2 patent references, and the Mackey-1 and Mackey-2 patent references, with a notation as to what their basic purposes were, this should be contrasted with the instant application USSN 09/813,668 entitled "Method For Calculating User Weights For Thin Client Sizing Tool". Here, the Examiner should note there is an entirely different purpose involved here, which involves a method for calculating the User weights which would be used during the solution generation and configuration process for an enterprise which uses a Thin Client Sizing Tool to propose an optimal configuration of Server Farms. Here, as specifically noted in Applicants' Fig. 1, Fig. 2A, Fig. 2B and Fig. 3, there is seen an essentially different set of operations which involve the calculation and use of categories of User types

and User weights which are designated as Light, Medium, Heavy and Super-Heavy, each of which are given a certain percentage of weighting factors (50%, 67%, 100%, 200%), which then can be utilized for input to the Application Solution Configurator program.

Per Examiner's request to cite the locations in the specification for certain of the rejected claimed limitations. these include:

(a) Show support for the limitation "application that processes 16-bit or MS-DOS programs accumulating the number of User-type Users for application categorized as Super-Heavy users ----

This is shown in Docket 041-513-L (the current instant application), which is illustrated at Fig. 2A, step E3, and also step E10 of Fig. 2A.

(b) There is the question of support for "eliminating applications involving a Heavy processing background and sorting out and eliminating those applications which involve heavy background processing.

This is shown at step E4 of Fig. 2A of the instant application.

(c) Support for selecting those User types whose typing speed is slower than 45 words per minute ---.

This is shown in Figs. 1, 2A, 2B, of the instant case, Docket 041-513-L, which is USSN 09/813,668.

Applicants would refer the Examiner to the specification of the instant case, starting from pages 22 through 27, which illustrates with specific examples, the use of these "weighted values" and also the various steps involved as seen in Figs. 1, 2A, 2B and Fig. 3.

Here, it should be noted that the purpose of Applicants' instant application has to do with calculating User weights which can be used as input to the solution generation and configuration process (step E16 of Fig. 1 gets fed into step D13 of Fig. 1B of USSN 09/813,670 (Docket 041-512-L), for an enterprise which uses a Thin Client Sizing Tool to propose an optimal configuration of Server Farms.

This is a completely different concept of use and operational factors from anything contemplated by the Smorodinsky and the Mackey patent references. It should also be emphasized that this information is used for an enterprise server farm Solution Configurator, as indicated in USSN 09/813,667 (Docket 041-509-L) and also for the Solution Generation method, as illustrated in the co-pending USSN 09/813,670 (Docket 041-512-L).

Applicants have now consolidated claims 5, 6, 7, 8 and 9, in order to show the overall basic essence of what is involved in developing and using the User types and the volume or velocity of usage for each User type and User application so that this information can then be put into the Solution Configurator.

In regard to certain aspects and clauses of the amended consolidated Fig. 5, which is extant in this case, Applicants would indicate that certain of the specific citations that Examiner has indicated against certain of the clauses will be seen to be of interest, but not specifically implementable, as regards the particular clauses involved, as will be illustrated hereinunder.

It should be remembered that a claim must be considered as a whole in its entirety and if there is no suitable reference in regard to one or more clauses of a claim, then the claim cannot be considered as a rejectable item in its entirety.

In a case designated as Ex parte Rozzi, there was an unpublished decision by the Board of Patent Appeals and Interferences, p. 1106, dated 1/16/02, where the following was indicated:

Patent Examiner's rejection of Applicants' claims on grounds of anticipation and obviousness over prior art are vacated, since Examiner has made no cogent attempt to read reference into independent claim in application, and therefore has not established that he determined that all limitations of Applicants' claims are explicitly or inherently described by prior art, and since Examiner's finding that independent claim is "generically" described by reference is insufficient for obviousness rejection; Examiner's rejection for anticipation based on second prior art reference is reversed, since that reference does not disclose specific combination of

components set out in Applicants' independent claim. (underlines added).

As a further legal citation, in the case of Uniroyal Inc., v. Rudkin-Wiley Corp., 837 F.2d, p.1044, and 5 USPQ2d, p.1434 (Fed.Cir.1988), it was stated:

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest desirability, and thus the obviousness of making the combination as it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.

There is nothing in Smorodinsky-1 and Smorodinsky-2, nor Mackey-1 and Mackey-2, to suggest the use of user weights for each User and for each application.

Now, looking at the Applicants' currently amended claim 5, it will be seen that clause (c) of claim 5 (on sorting out and eliminating applications which are graphics-based) has been referenced by the Examiner according to Smorodinsky-1, Fig. 3, column 10, lines 50-60, and Smorodinsky-2, Fig. 3, column 10, lines 50-60, plus Mackey-1, Fig. 3, column 10, lines 50-60.

Smordinsky-1 at Fig. 3 is merely a Server Farm time diagram with a bar chart showing the usable time periods of three servers. Then Smorodinsky-1, column 10, lines 50-60, is merely a summary statement saying that a group of parameters

can be used to estimate the Server Farm size, the availability of the Server Farm and the downtime of the Server Farm for a selected required number of clients (Users). Notice this involves a particular number of clients, but does not contemplate the "Configuration Interview Session Method for Thin Client Sizing Tool" as was indicated in USSN 09/813,671 (Docket 041-510-L). Anticipatory teaching cannot be substantiated from Smorodinsky on clause 5(c), nor any number of other claim clauses which show limitations in Applicants' claims.

Now, in regard to Smorodinsky-2, Fig. 3, column 10, lines 50-60 --- there is no such reference in Smorodinsky-2.

Further, in regard to clause (c) of claim 5, the Examiner has cited the Mackey-1 patent, Fig. 3, column 10, lines 50-60 --- here, it should be noted that Fig. 3 of Mackey-1 is merely a flowchart showing steps for executing applications on each simulated client. Then, in regard to Mackey column 10, lines 50-60, there is no such material in the Mackey-1 patent.

Thus, it should be noted that Applicants' claim 5(c) on --- sorting out and eliminating those applications which are graphic-based or animated --- there is no warrant here on Examiner's part for saying that clause (c) has been taught by these references. Implications and extrapolation do not constitute anticipatory teaching.

Now, again, looking at Applicants' currently amended claim 5(i) where Examiner has cited Smorodinsky-1, column 5, lines 6-14, Table 1, column 9; column 2, lines 61 through column 3, line 43.

Here, looking at Smorodinsky-1, column 5, lines 6-14 -- this is merely a "generalized statement" saying that Smorodinsky Fig. 1 is an application Server Farm and has a database server 40 and a set of client terminals --- note that nothing is indicated here which would refer to claim 5(i) on utilizing a weight factor of 50% to establish a value for users of the Light usage category.

Further, regarding Applicants' claim 5(i) (utilizing a 50% weight factor for Light users), Examiner has cited Smorodinsky-2, column 5, lines 6-14, Table 1, column 9; column 2, line 61 through column 3, line 43.

Here, Smorodinsky-2, column 5, lines 6-14, only states --- a testing environment equipped with 15 personal computers and that it is important to know the performance and load capacities for the terminal services operating system. This cannot be extrapolated to teach weight factors.

Again, we can see here that there is no correlation to Applicants' claim 5(i) regarding --- utilizing a weight factor of 50% to establish the value for users of the Light usage category.

Further, in regard to the Applicants' extant claim 5(i), Examiner has cited Smordinsky-1, column 2, line 61 to column 3, line 43 ----- this series of paragraphs of Smorodinsky-1 merely discusses the use of various parameters and the use of an estimator program using input parameters to generate estimate of Farm size for the Farm that will comprise Servers with given parameters and will be able to serve at least the given

particular number of clients (n). This "generality" cannot be extrapolated to teach user-weights.

Certainly, this does not teach the substance of claim 5(i) on utilizing a weight factor of 50% for Users of the Light usage category.

Further, in regard to Applicants' claim 5(i), Examiner has cited the Mackey-1 patent at column 5, lines 6-14, and also column 2, lines 61 through column 3, line 43.

It will be seen that the reference in Mackey column 5 ---- only describes the testing environment which is equipped with eight sets of 15 PC's, and . . . that it is important to know the performance and load capacities for terminal services operating system. . . .

Further, at Mackey-1, columns 2-3, there is referenced that Mackey Fig. 5 is a graph showing a number of simulated client users and another graph which shows the percent utilization of the total possible utilization for each point of the number of active client users.

These references certainly do not teach or indicate Applicants' clause (i) on utilizing a weight factor of 50% to establish a value for users of the Light usage category.

Further, regarding the use of weight factors for Medium users, Heavy users, etc., plus the accumulation of such type of users, Examiner has cited Mackey-1, column 7, lines 34-67; column 7, lines 6-14 and 35-55; column 7, lines 6-14, lines 35-55; column 2, line 61 to column 3, line 43, in addition to column 5,

lines 6-14, and column 2 line 61, to column 3, line 43. Here, there is no teaching of --- a usage slower than 45 words per minute. This series of statements merely discusses operations of Fig. 3 involving the usage of various script commands.

Regarding Applicants' claim 5(i), re column 7 of Mackey-1 at lines 6-14 and 35-55 --- this merely talks about various test scripts, it does not set-up any categories for Medium usage, as indicated in Applicants' claim 5(i).

Likewise, in the Mackey-1 reference, there is nothing to indicate the value of a Heavy category of usage, where Examiner has cited Mackey-1 column 7, lines 6-14 and lines 35-55, nor column 2, line 61 though column 3, line 43, which basically only gives ---- definition of client scripts, control, exchange and graphical updates.

While the Examiner has done a very detailed and conscientious job in citing various references of Smorodinsky and Mackey, it should be noted that Examiner has apparently "extrapolated" and "intimated" various meanings from these passages which are not instructive in regard to the use of Light, Medium, Heavy and Super-Heavy weight values.

Thus, there is no way that there are any references which can teach each and every single one of the clauses involved in Applicants' claim 5.

As was previously stated in the cited case of Ex parte Rozzi, where the Board decided that . . . Examiner has not established that he determined that all limitations of Applicants' claims are explicitly or inherently described by prior art. . . .

In view of the factors whereby the cited references cannot explicitly teach each and every clause of Applicants' claim, and further whereby the specifically cited portions of Smorodinsky and Mackey certainly cannot be considered to teach

the cited elements of the claim clauses of Applicants' claim 5, but only could be considered to be of use "by means of implication and extrapolation" which Examiner has done, since there is no specific teaching which could particularize and zero-in on the actual claim language involved.

Further, as is the stated law of patents, a claim must be considered as a whole in its entirety, and further, there is a different type of problem being solved by Applicants' specification than that of the cited references, even though there may be a few similarities here and there in regard to optimization of Server Farms.

Applicants' situation involves a Sizing Tool which enables a series of databases to be developed which provide for various elements of information and parameters which can be used for an Application Solution Configurator in order to optimize the configuration of a series of Server Farms with certain specific peculiarities which are not contemplated or taught by the cited references. In the present case, there is no teaching of the categories of User types and User applications which are "added" to indicate the volume of usage in regard to Light, Medium, Heavy or Super-Heavy, which is an important factor in the establishment of the optimal configuration.

Thus, when observing the difference in purpose and functionality of Applicants' methodology over that of the cited references, and specifically in regard to the use of various weight factors which have not been taught by any references, it should be understood that the sequence of limitations provided by Applicants perform a unique combination which should be recognized as a whole in its entirety. Therefore, it is

requested that Examiner observe these improved limitations and subsequently provide a timely Notice of Allowance therefor.

Respectfully submitted,

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

July 18, 2005

Patti S. Preddy

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